

REMARKS

This is intended as a full and complete response to the Office Action dated September 12, 2003, having a shortened statutory period for response set to expire on December 12, 2003. Claims 1-43 are pending in the application. Claims 12-34 and 43 are allowed. Claims 1, 5-8, 10, 11, 35, 39, 41, and 42 stand rejected. Claims 2-4, 9, 36-38, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have cancelled claims 35 and 40 and amended claims 36, 39 and 41 for reasons set forth below. Please reconsider the claims pending in the application for reasons discussed below.

In the specification, Applicants have amended paragraph [0031] as shown above to obviate the objection. Accordingly, withdrawal of the objection is respectfully requested.

In the drawings, Applicants have amended Figure 1 to include the reference sign "270" that had been inadvertently omitted. Withdrawal of the objection is respectfully requested.

Claims 39, 41 and 42 stand rejected under 35 USC § 102(e) as being anticipated by *Emesh et al.* (2002/0108861). Applicants have cancelled claim 40 and have amended independent claims 39 and 41 to include the allowable subject matter of claim 40. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 35 stands rejected under 35 USC § 102(a) as being anticipated by *Barton et al.* (U.S. Patent No. 6,280,598). The Examiner states that *Barton et al.* discloses an electrolyte composition comprising about 2 to about 23 percent by weight of ammonium dihydrogen phosphate, diammonium hydrogen phosphate, or a mixture thereof.

Applicants have cancelled claim 35 and presented claim 36 in independent form to obviate the rejection. Claim 36 and those dependent therefrom are in condition for allowance. Accordingly, withdrawal of the rejection and allowance of claims 36-38 is respectfully requested.

Claims 1, 5-8, and 10-11 stand rejected under 35 USC § 103(a) as being unpatentable over *Emesh et al.* (2002/0108861). The Examiner states that *Emesh et al.*

discloses a method for planarizing a surface of a wafer comprising polishing the wafer in an electrolyte composition comprising a phosphate system, wherein the wafer is connected to an electrical power source. The Examiner then admits that *Emesh et al.* does not disclose a pH from about 3 to about 10. The Examiner, however, asserts that it would have been obvious to have adjusted the pH of the electrolyte in *Emesh et al.* to provide "suitable control over the uniformity and rate of removal of metal thereby improving product quality and overall process efficiency."

Applicants respectfully traverse this rejection. The Examiner's reason for obviousness is simply an "obvious to try" standard which the Court of Appeals for the Federal Circuit has held not to be a proper test for determining obviousness under 35 U.S.C. § 103. See *In re O'Farrell*, 7 U.S.P.Q. 2d 1673 (Fed. Cir. 1988). *Emesh et al.* teaches adjusting conditions of the electrochemical planarization process, "such as the electric potential, distance between the electric conductors and the metallized surface, conductivity of the electrolytic planarization solution, temperature, hydrodynamic conditions, and mechanical integrity of the passivation film." (See *Emesh et al.* at paragraph 55.) There is no mention of an electrolyte pH within *Emesh et al.* Insofar as the record shows, if it is known or obvious to adjust the pH of an electrolyte to provide "suitable control over the uniformity and rate of removal of metal thereby improving product quality and overall process efficiency," this has been gleaned from the Applicants' own specification. This is nothing more than impermissible hindsight.

The Examiner is kindly reminded that the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the Applicants' disclosure. See M.P.E.P. § 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Since there is no motivation or suggestion within *Emesh et al.* to adjust the pH of the electrolyte and there is no teaching or motivation of an electrolyte composition comprising a phosphate system having a pH from about 3 to about 10, as recited in the claims, the claimed invention is not obvious in view of *Emesh et al.* Accordingly, withdrawal of the rejection is respectfully requested.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Robb D. Edmonds
Registration No. 46,681
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants

